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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,924	08/27/2003	David M. List	29031.00002	1923

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EXAMINER

AIRAPETIAN, MILA

ART UNIT	PAPER NUMBER
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3625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/604,924

Applicant(s)

LIST ET AL.

Examiner

Mila Airapetian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Applicant's amendment received on 01/31/2007 is acknowledged and entered. The applicant has amended claims 1, 3, 5, 10 and 20. Currently, claims 1-20 are pending for examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1, 10 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

Claim 1 recites the limitation "providing a sample of the recorded material...".

Claim 20 recites the limitation "collecting sales data on a server related to the quantity...".

Claim 20 recites the limitation "downloading the recording material...".

There is insufficient antecedent basis for these limitations in the claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5, 8-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramachandran et al. (US 2001/0044747) in view of Bock (US 2003/0182156).

Claim 1. Ramachandran et al. (Ramachandran) teaches a method for dispensing digital information from an automated transaction machine, comprising the steps of:

accessing a terminal, said terminal having access to at least one recorded item and including at least one storage medium [0047];

providing a sample of the recorded material selected that a user can listen to or view in said terminal [0046];

selecting at least one of said at least one recorded item [0047];

adding said selected at least one recorded item to a list [0057];

recording said at least one selected item to said storage medium [0030]; and

dispensing said storage medium [0043].

However, Ramachandran does not teach that said dispensed storage medium is dispensing in a case.

Bock teaches a method for reproducing works of authorship in a form of CD, wherein said CD is dispensed in a case [0018].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ramachandran to include dispensing a case that contains said storage medium, because it would advantageously allow to include inserts, that may include information relating to the work of authorship into a storage case dispensed with new medium, so the user can easily identify digital data stored on said medium [0039].

As per "seat or bench" feature, it is well known that people can sit when they listen to recorded material in the stores.

Also, said information cannot affect the method steps recited, therefore, is not given patentable weight.

Claim 5. Ramachandran teaches said method further comprising the step of selecting a payment type [0062].

Claim 8. Ramachandran teaches said method further comprising the step of recording data on a data collection server ("*... connected computer is operative to keep records of each dispense of digital content*") [0062]).

Claim 9. Ramachandran teaches said method further comprising the step of accessing the recorded data [0033].

Claim 10. Ramachandran teaches a system for dispensing digital information from an automated transaction machine, comprising:

a terminal having access to recorded material and configured to download recorded material selected by a user to a storage medium [0047]; and a

dispenser connected to said terminal configured to distribute said storage medium having said selected recorded material recorded thereon [0043].

Claim 11. Ramachandran teaches said system wherein said terminal includes a hard drive with recorded material stored therein [0051].

Claim 12. Ramachandran teaches said system wherein said terminal is communicatively connected to a supply server having recorded material stored therein [0047].

Claim 13. Ramachandran teaches said system wherein said terminal is communicatively connected to an Internet [0043].

Claim 14. Ramachandran teaches said system wherein said supply server is communicatively connected to an Internet [0043].

Claims 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramachandran in view of Pollak (US 2003/0004833).

Claim 15. Ramachandran teaches all the limitations of claim 15 except that said terminal is communicatively connected to a data collection server.

Pollak teaches a system for vending electronic entertainment terminal is communicatively connected to a data collection server ([0010], page 3, claim 1-2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ramachandran to include that said terminal is communicatively connected to a data collection server, as disclosed in Pollak, because it would advantageously allow to stimulate content providers to supply their digital content.

Claim 16. Ramachandran teaches all the limitations of claim 16 except that said data collection server is communicatively connected to a website accessible by third parties.

Pollak teaches a system for vending electronic entertainment terminal wherein said data collection server is communicatively connected to an Internet (page 3, claim 1-2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ramachandran to include that said data collection server is communicatively connected to an Internet, as disclosed in Pollak, because it would advantageously allow to stimulate content providers to supply their digital content.

Claim 17. Ramachandran teaches a system for dispensing digital information from an automated transaction machine wherein said data collection server ("*... or other connected computer*") is communicatively connected to a website accessible by third parties [0066].

Claim 18. Ramachandran teaches said system wherein said data collection server collects data related to quantity of sales of said selected recorded materials [0062], [0066].

Claim 19. Ramachandran teaches said system wherein said third parties are copyright owners [0066].

Claim 20. Ramachandran teaches a method for dispensing digital information from an automated transaction machine, comprising the steps of:

selecting at least one recorded item from a list of recorded items available for purchase [0047];

purchasing said at least one recorded item [0070];

However Ramachandran does not teach:

collecting sales data on a server related to the quantity of sales;

communicating sales data to an internet website; and

accessing said data to determine applicable royalty payments due.

Pollak et al. (Pollak) teaches a method for vending electronic entertainment including collecting sales data on a server related to the quantity of sales; communicating sales data to an internet website; and accessing said data to determine applicable royalty payments due ([0010], page 3, claim 1-2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ramachandran to include collecting sales data on a server related to the quantity of sales; communicating sales data to an internet website; and accessing said data to determine applicable royalty payments due, as disclosed in Pollak, because it would advantageously allow to stimulate content providers to supply their digital content.

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Ramachandran and Bock, as applied to claim 1, in view of Parker (US 4,703,465).

Claim 3. The combination of Ramachandran and Bock teaches all the limitations of claim 3 except designing a label; and printing said label on one of a protective case and said storage medium.

Parker teaches a method for producing an audio magnetic tape recording from a music library wherein the specific label for the cassette is printed (col. 1, lines 55-56, col. 4, lines 42-45)).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ramachandran and Bock to include a feature of printing a label, as disclosed in Parker, because it would advantageously allow the user to readily recognize the content of the digital content without using the medium thereby facilitating management of the recorded file.

Claim 4. The combination of Ramachandran and Bock teaches all the limitations of claim 4 except including said list on said label.

Parker teaches a method for producing an audio magnetic tape recording from a music library wherein said list is included on said label (col. 4, lines 42-45).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ramachandran and Bock to include that said list is included on said label, as disclosed in Parker, because it would advantageously allow the user to readily recognize the content of the digital content without using the medium thereby facilitating management of the recorded file.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Ramachandran and Bock, as applied to claim 1, in view of Rosenberg (US 6,363,357).

Claim 2. The combination of Ramachandran and Bock teaches all the limitations of claim 2 except previewing said selected at least one recorded item.

Rosenberg teaches a method for selling a digital content product in an online commercial transaction wherein the buyer may preview the product before purchasing (col. 5, line 63).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ramachndran and Bock to include previewing selected

item, as disclosed in Rosenberg, because it would advantageously allow to avoid possible mistakes by purchasing wrong items.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Ramachandran and Bock, as applied to claim 1, in view of Kamen et al. (US 5,135,012).

Claim 6. The combination of Ramachandran and Bock teaches all the limitations of claim 6 except affixing a magnetic strip to said case.

Kamen et al. (Kamen) teaches a compact case employing a pivotable lid wherein magnetic strip is affixed to the compact case (col. 7, lines 55-58).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ramachandran and Bock to include affixing a magnetic strip to said case, as disclosed in Kamen, because it would advantageously allow to releasably attach various product to said case thereby providing convenience to the customer (col. 2, lines 4-8).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Ramachandran, Bock and Kamen, as applied to claim 6, in view of Cho (US 2004/0064374).

Claim 7. The combination of Ramachandran, Bock and Kamen teaches all the limitations of claim 7 except of the step of paying a cashier.

Cho teaches a method for retail distribution of customized media content including paying a cashier for the downloaded songs [0035].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Ramachandran, Bock and Kamen to include paying a cashier feature, as disclosed in Cho, because it would advantageously allow to obtain this product in a store.

Response to Arguments

Applicant's arguments filed 01/31/2007 have been fully considered but they are not persuasive.

In response to Applicant's arguments that the prior art does not teach "*providing a sample of the recorded material selected that a user can listen to or view*", it is noted that Ramachandran explicitly teaches said feature. Specifically, Ramachandran teaches "audio and/or visual outputs may also be provided to identify, and in some cases enable the user to sample the available information [0046].

In response to Applicant's arguments that the prior art does not teach a terminal for dispensing storage medium created by the user which includes a seat or bench to enable the user to sit comfortably, it is noted that Ramachandran teaches dispensing said storage medium [0043]. As per "sitting comfortably" feature, said feature is not

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recited in the rejected claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to Applicant's arguments that the prior art does not teach "*wherein the user designs a personalized label to be affixed to the storage medium*", it is noted that Parker does, in fact, teach said feature. Parker teaches a method for producing an audio magnetic tape recording from a music library wherein the specific label for the cassette is printed (col. 1, lines 55-56; col. 4, lines 42-45).

In response to Applicant's arguments that the prior art does not teach calculating royalty amounts for a particular copyright owned, it is noted that Pollak teaches said feature. Specifically, Pollak teaches a method for vending electronic entertainment including calculating royalty payments ([0010], page 3, claims 1,2).

In response to Applicant's arguments that the prior art does not teach that "*the user is requested to select a payment type*", it is noted that Ramachandran teaches said feature [0076].

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Ramachandran

and Pollak references are directed to a method and system for dispensing digital material from an automated transaction machine. The motivation to combine the references would be to advantageously stimulate content providers to supply their digital content.

Regarding claim 5. The claim is rejected under 35 U.S.C. 103(a) as being unpatentable over Ramachandran in view of Bock.

Claims 17 through 19 are rejected as being unpatentable over Ramachandran in view of Pollak, as applied to claim 16.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the combination of Ramachandran and Bock discloses a CD dispensed in a compact case. Kamen discloses similar compact case having a magnetic strip affixed to a case. The motivation to combine the references would be to allow to releasably attach various product to said case thereby providing convenience to the customer.

In response to Applicant's arguments that the intended use in the methods as claimed are completely divergent from the magnetic strip taught by Kamen, that is the magnetic strip is not used to seal the case, but solely as a label for verifying the data

content on the storage media, it is noted that the said "label" feature which Applicant relies on in claim 6 is not recited in the claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to Applicant's arguments that the use of a card to access and pay for a customized storage medium requiring an account database is not required in the invention, it is noted that Cho was applied only for "paying a cashier" feature.

In response to Applicant's argument that "*an account database is not required in paying the cashier*", it is noted that the feature upon which applicant relies are not recited in the rejected claim 7. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to Applicant's argument that "*claim 20 of this invention is drawn to Internet access method which is not disclosed in Parker*", it is noted that Internet access was disclosed in Ramachandran. Specifically, Ramachandran teaches:

[0026] "*an automated transaction machine that is operative to offer a selection of digital sound recordings to play that are downloaded from a network such as the Internet*".

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mila Airapetian whose telephone number is (571) 272-3202. The examiner can normally be reached on Monday-Friday 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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